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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/730,878

12/09/2003

Ruchika Singhal

1023-334US01

4796

28863 7590 02/20/2007  
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EXAMINER

KAHELIN, MICHAEL WILLIAM

ART UNIT

PAPER NUMBER

3762

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/20/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

NT

**Office Action Summary**

Application No.

10/730,878

Applicant(s)

SINGHAL ET AL.

Examiner

Michael Kahelin

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 20070130; 20061103.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: IDS: 20061018; 20060718.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see "Remarks", filed 10/18/2007, with respect to the rejection(s) of claim(s) 1-14 under 35 USC 102 and 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of new art.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-13, 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Berrang et al. (US 6,358,281, hereinafter "Berrang").

4. In regards to claims 1, 9 and 16, Berrang discloses an implantable device comprising at least two interconnected modules (Fig. 2, elements 2 and 3), each having a housing (col. 11, line 55); and an overmold encapsulating each of the housings (col. 12, lines 8-25) and comprising a lead connection module (Fig. 1, intersection of 6 and 16). Please note an alternate interpretation wherein electronic module (21) is housed

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by support disc (33) and battery (18) inherently comprises its own housing because the battery is a lithium ion or nickel metal hydride-type (col. 12, line 55). These batteries contain liquid electrolytes necessitating a housing. In this interpretation, the epoxy and gold act as the overmold. Further, regarding claim 16, the epoxy acts as a frame because it is rigid.

5. In regards to claim 2, at least one module contains electronic components (21).

6. In regards to claims 3 and 13, the overmold comprises a first material and a second material (col. 12, line 8) and the lead connection module is deployed within the first material (because the lead conductors must pass through all coating materials (the epoxy, gold, palladium, titanium, and silicone of column 12, line 20) to reach the outside of the device, the lead connection module passes through the "first material").

7. In regards to claims 4, 10 and 17, the first material is non-elastomeric; depending on whether the epoxy resin, gold, or the other listed materials is considered to be "the first material".

8. In regards to claim 5, the device includes at least one feed-through wire (col. 11, line 3).

9. In regards to claims 6 and 7, the lead connection module necessarily includes a mechanical lead securing mechanism because the lead is attached to the device and is tool-less because it is integral.

10. In regards to claim 8, the maximum thickness is between 4 and 8 millimeters (col. 10, line 9).

11. In regards to claims 11, 12 and 18, the second material is silicone (col. 12, line 25).

12. In regards to claim 15, the modules are horizontally distributed and separately encapsulated by the overmold (Fig. 2).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berrang. Berrang discloses the essential features of the claimed invention except for an isodiametric lead. It is well known in the art to provide implantable devices with isodiametric leads to allow the leads to be easily manufactured by extrusion processes

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and implanted with tubular catheters. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Berrang's invention by providing an isodiametric lead to allow the lead to be easily manufactured by extrusion processes and implanted with a tubular catheter.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Eddington (US 4,617,913) is one of many teachings of utilizing an isodiametric lead.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Kahelin whose telephone number is (571) 272-8688. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

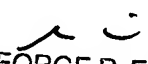
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MWK\*



2/13/07



GEORGE R. EVANISKO  
PRIMARY EXAMINER

2/15/7